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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,454	10/20/2003	Keiichi Aoki	KOT-0083	4178

7590 12/06/2004

CANTOR COLBURN LLP  
55 Griffin Road South  
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EXAMINER
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LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

10/689,454 Aoki

LAMB

1734

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 9/16/2004, 12/29/2003, 10/20/2003
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-2 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-2 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 12/29/2003 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

Office Action Summary

Applicant's election of Group I and cancellation of non-elected claims 3-12 of Group II in Paper filed 9/16/2004 is noted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Japan 02-207865.

Japan '865 teaches the design of a coating apparatus comprised of the following elements: a slot coater for coating a layer of a liquid coating composition onto a web, the slot coater comprising a lip plane which as shown comes into contact with the liquid coating composition having a center-line surface roughness Ra of the lip plane is equal to or less than 0.5  $\mu\text{m}$ . Japan '865 inherently includes a supplier to provide the flow of coating as shown by arrow A in Figure 2 into the input conduit 10 of the slot coater. The recitation in claim 1 that the apparatus produces a silver salt photographic thermographic material is intended end use and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed

structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Note the Japan '865 is capable of producing a silver salt photographic thermographic material since it teaches every positively claimed structural element of apparatus.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ghost et al 5,484,629.

Ghost et al teaches the design of a coating apparatus comprised of the following elements: a slide coater for coating a layer of a liquid coating composition onto a web, the slide coater comprising a slide plane 20 which as shown comes into contact with the liquid coating composition as it exits the coating slot 18. Ghost et al inherently includes a supplier to provide the flow of coating to the feed conduits 16 as disclosed at column 3 lines 27-36. Ghost et al teaches reducing the roughness of the slide surface by polishing to reduce the number of streaks formed on the substrate. Ghost et al teaches the average roughness of the slide plane is 0.05 to 0.1 um (see column 4 lines 44-47). Ghost et al fails to teach the average surface roughness of the slide plane is a center-line surface roughness Ra and the center-line surface roughness Ra is within the scope of the claim. However, it would have been prima facie obvious to reduce the roughness of the slide plane of the Ghost et al slide coater such that it is within the scope of the claim or one having minimal levels of roughness such as a center-line surface roughness Ra of equal to or less than 0.5 um for the taught advantages of reducing the roughness of the slide plane to minimal levels – reduced occurrence of streaks on the coated substrate. The recitation in claim 2 that the apparatus produces a silver salt photographic thermographic material is intended end use and it has been held that a

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). Note the Ghost et al is capable of producing a silver salt photographic thermographic material since it teaches every positively claimed structural element of the apparatus.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ghost et al 5,484,629 in view of Fukuda et al.

Ghost et al teaches the design of a coating apparatus comprised of the following elements: a slide coater for coating a layer of a liquid coating composition onto a web, the slide coater comprising a slide plane 20 which as shown comes into contact with the liquid coating composition as it exits the coating slot 18. Ghost et al inherently includes a supplier to provide the flow of coating to the feed conduits 16 as disclosed at column 3 lines 27-36. Ghost et al teaches reducing the roughness of the slide surface by polishing to reduce the number of streaks formed on the substrate. Ghost et al teaches the average roughness of the slide plane is 0.05 to 0.1  $\mu\text{m}$  (see column 4 lines 44-47). Ghost et al fails to teach the average surface roughness of the slide plane is a center-line surface roughness  $R_a$  and the center-line surface roughness  $R_a$  is within the scope of the claim. However, it would have been prima facie obvious to reduce the roughness of the slide plane of the Ghost et al slide coater such that it is within the scope of the claim or one having minimal levels of roughness such as a center-line surface roughness  $R_a$  of equal to or less than 0.5  $\mu\text{m}$  for the taught advantages of reducing the roughness of the slide plane to minimal levels – reduced occurrence of streaks on the

coated substrate and especially since Fukuda et al teaches minimizing roughness of the surfaces of the slide coater in contact with coating to levels within scope of the claim to reduce the occurrence of streaks on the coated substrate. The recitation in claim 2 that the apparatus produces a silver salt photographic thermographic material is intended end use and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). Note the Ghost et al is capable of producing a silver salt photographic thermographic material since it teaches every positively claimed structural element of the apparatus.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lamb/dh  
December 3, 2004

  
BRENDA A. LAMB  
PRIMARY EXAMINER